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TTAB

5137-103 US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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FRAM TRAK INDUSTRIES, INC.,	:	
	:	
Petitioner,	:	Cancellation No.: 92043947
	:	
vs.	:	
	:	
WIRETRACKS LLC,	:	
	:	
Registrant.	:	
-----	X	

PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR
SUMMARY JUDGMENT

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10-11-2005

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #34

Fram Trak Industries, Inc. (hereinafter "Fram Trak" or "Petitioner") submits this short reply brief in support of its Motion for Summary Judgment to clarify the only salient issue in this proceeding – priority of use. Petitioner respectfully requests that the Trademark Trial and Appeal Board (hereinafter "TTAB" or "Board") exercise its discretion and consider this reply brief. *See* 37 CFR § 2.127(a). *See also, e.g., Seculus da Amazonia S/S v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, n.4 (TTAB 2003). This reply brief is timely because it has been filed within twenty days from the date of service of Registrant WireTracks LLC's Response to Motion for Summary Judgment that was served on Petitioner via first-class mail on September 16, 2005. *See* 37 CFR § 2.119(c).

On September 16, 2005 Registrant, WireTracks LLC (hereinafter "Registrant" or "WireTracks"), filed a Response to Motion for Summary Judgment in this matter. In that document, Registrant has not established that there is a genuine issue regarding any material fact in this matter. Specifically, Registrant has not disputed that Petitioner has standing. With regard to Petitioner's grounds for cancellation, Registrant has not disputed that Petitioner's and Registrant's marks are confusingly similar. Accordingly, Registrant's sole argument in its Response to Motion for Summary Judgment is that Registrant has priority over Petitioner. As set forth in detail in Petitioner's Brief in Support of its Motion for Summary Judgment and summarized below, it is clear that Petitioner has priority in this matter.

Registrant's claim of priority appears to be based on "the legal standard of public exposure of its mark" and Registrant purports to support that claim by alleging that its advertising and

marketing efforts have “made a significant impact on the purchasing public.” *See* Registrant’s Response to Motion for Summary Judgment. Registrant’s comparison of its marketing and advertising efforts versus those of Petitioner is misguided and has no bearing on the issue of priority. These arguments are merely red herrings intended to distract the Board from the only relevant issue, namely, priority of use.

Registrant appears to confuse the legal standard of use of a mark in preparing to do business with establishing priority of rights in a trademark through actual use of that mark in commerce. Here, Petitioner does not have to rely on any pre-sale activity because Petitioner’s first sale of goods under the marks “WIRE TRAK” and “WIRE TRAK & DESIGN” predated both Registrant’s purported pre-sale activity and Registrant’s first sale of goods under the mark “WIRETRACKS.”

Petitioner’s first sale of “WIRE TRAK” products was made on July 3, 2002. *See* Declaration of Albert Santelli, Sr. in Support of Petitioner’s Motion for Summary Judgment (hereinafter referred to as “Santelli Dec.”) at ¶ 22 and Exhibit “L” thereto. This date is earlier than both Registrant’s purported pre-sale activity and Registrant’s first sale of goods under the mark “WIRETRACKS.” Registrant’s first alleged pre-sale activity did not occur until the registration of the domain name WIRETRACKS.COM on December 23, 2002¹. Declaration of Bruce Gutman, in Support of Registrant’s Response to Petitioner’s Motion for Summary Judgment (hereinafter referred to as Gutman Dec.), ¶ 2 and Attachment W2 thereto. Accordingly, Registrant had no pre-sale activity until more than five months after Petitioner’s first

¹ The registration of the WIRETRACKS.COM domain name did not create any trademark rights in the mark “WIRETRACKS.” *See Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 50 USPQ2d 1545, 1555 (9th Cir. 1999).

sale of goods under the marks "WIRE TRAK" and "WIRE TRAK & DESIGN." In addition, Registrant's first sale of "WIRETRACKS" products was not made until April 7, 2003. Gutman Dec. at ¶ 5 and Attachment B thereto. Therefore, Registrant's first sale did not take place until more than eight months after Petitioner's first sale.² As a result, Petitioner has priority over Registrant.

While Petitioner's July 3, 2002 invoice, generated in connection with Petitioner's first sale of "WIRE TRAK" products, does not include the mark "WIRE TRAK" or "WIRE TRAK & DESIGN," this is of no consequence because of Petitioner's uncontroverted testimony. The Declaration of Albert Santelli, Sr. in Support of Petitioner's Motion for Summary Judgment confirms that the products referenced on the July 3, 2002 invoice were shipped in packaging that included a label bearing the "WIRE TRAK" mark. Santelli Dec. at ¶ 23. In fact, Exhibit M to the Santelli Dec. presents an example of the label that was used on the packaging for the products sold on July 3, 2002. Without question Petitioner has established priority based on its sales of product under the marks "WIRE TRAK" and "WIRE TRAK & DESIGN." Registrant's unsupported allegation surrounding Petitioner's first sale has not countered Petitioner's evidence regarding priority. As a result, Registrant has failed to show that there is a genuine issue of fact for trial regarding the issue of priority – the only issue in this matter.

² As set forth in detail in Petitioner's Brief in Support of its Motion for Summary Judgment, Petitioner adopted the mark "WIRE TRAK" in late 2001 and began to use that mark in preparing to do business under that mark at least as early as November 20, 2001. This date is thirteen months before Registrant's claimed pre-sale activity and more than sixteen months before Registrant's first sale of "WIRETRACKS" products. As mentioned above, because Petitioner's first sale of goods under the marks "WIRE TRAK" and "WIRE TRAK & DESIGN" predated both Registrant's purported pre-sale activity and Registrant's first sale of goods under the mark "WIRETRACKS," Petitioner does not have to rely on any pre-sale activity to establish priority.

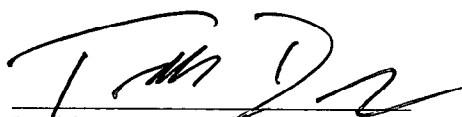
For the reasons set forth in Petitioner's Brief in Support of its Motion for Summary Judgment as well as above, Petitioner has demonstrated that there is no genuine issue as to any material fact. As a result, Petitioner is entitled to summary judgment as a matter of law and the Petition for Cancellation of United States Trademark Registration Number 2,883,311 should be sustained and said registration cancelled under Section 14 of the Lanham Trademark Act, 15 U.S.C. §1064.

Respectfully submitted,

Fram Trak Industries, Inc.

Dated: 10/6/2005

By:



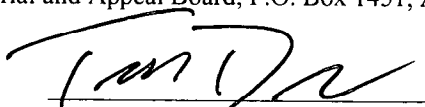
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CERTIFICATE OF MAILING

I hereby certify that Petitioner's Reply Brief in Support of its Motion for Summary Judgment is being deposited with the United States Postal Service as first class mail in an envelope addressed to: United States Patent And Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, VA 22313-1451.

10/6/2005

(Date of Deposit)



(Signature)

10/6/2005

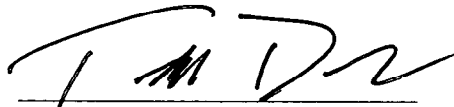
(Date of Signature)

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of Petitioner's Reply Brief in Support of its Motion for Summary Judgment was served, this 6th day of October, 2005, via First Class Mail, Postage Prepaid, addressed to Registrant's counsel, as follows:

**Michael J. Foycik, Jr.
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By:



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